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EXAMINER

CHEN, TE Y

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/885,356

Applicant(s)  
Alpha

Examiner  
Susan Chen

Art Unit  
2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 22, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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**Response to Amendment**

1. This is in response to amendment filed on 09/22/2003.
2. Claims 1-20 are pending for examination, claims 1-2, 7-8, 12, 16 and 20 have been amended.

***Specification***

3. The amendment filed on 09/22/2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The citations of "a second total term weight that is less than the first total term weight" at paragraphs [0006], [0007] and [0026] are new matters, because the critical terms/subfunction of the invention are not defined in the original specification.

The citations of "In equation(1) above, let  $S_i$  represent the score produced by an individual term or branch of query, let  $W_i$  represent the weight assigned to an individual term or branch and let  $\text{sum}(W_i)$  represent the mathematical sum of the weights  $W_i$  assigned to individual terms" at paragraph [0039] are new matters, because the critical terms/subfunction of the invention are not defined in the original specification.

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For the purpose of continuing prosecution of instant application. Applicant is required to cancel the new matter from the instant application.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 13-20, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

In the present case, claim 1 only recites an abstract idea. The recited steps of merely optimizing a response time for retrieving relevant documents from a set of candidate documents via associating a document to a relevance score bin base on a certain mathematical modal calculation and comparison that does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These claimed steps only drawn an idea for optimizing document retrieving response time without a useful, concrete and tangible utility, since the claimed invention, as a whole, is not

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within the technological arts as explained above, these claims are deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-12, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 1, 7 and 8, the citations of “a second total term weight that is less than the first total term weight” are new matters, since it is not defined and supported by the original specification.

As to claims 2-6, 9-12, these claims have the same defect as their base claims, hence are rejected for the same reason.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-20, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 13 and 20, applicant fails to define the terms/sub-function (e.g., the term Si, the function  $\text{sum}(W_i)$ , see page 14, line 1 - page 15, line 14) listed in the formula (1) for computing total relevance score of the invention, because this formula (1) is the only formula listed by the instant invention to calculate claimed total relevance score, therefore, without a full, clear, concise, and exact definition of the important formula, it is not enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention as claimed by applicant.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-20, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. As to claims 1, 7 and 8, it is not understood what are the claimed “a first total term weight” and “a second total term weight” referred to? What is the link between the claimed “a first total term weight” and “a second total term weight”? How to compute these first and second total term weight?

10. As to claims 2-7 and 9-12, these claims have the same defects as their base claims, hence are rejected for the same reason.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wical (U.S. Patent No. 6,460,034).

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13. As to claims 1-3, 5-8, 10-16 and 18-20, Wical discloses an object retrieval system [e.g., see Abstract, Fig. 1] with apparatus, methods and computer program products as claimed by applicant, to perform the following processing, comprising:

- \* logic for processing a search query having one or more terms [e.g., the content processing system (110), Fig. 1; col. 6, lines 23-33] wherein, the processing logic comprising: a) assigning a term weight to each of the terms [e.g., the Generate query term strengths unit (402), Fig.5]; b) associating a document to a relevance score bin based on a total matched term weight [e.g., col. 23, lines 26-60, Table 14].

- \* object retrieval logic for identifying candidate objects that match the search query [e.g. The query processing module (175), Fig. 1; 205, Fig. 2; col. 8, lines 58-65];

- \* ranking logic for assigning a term weight to each of the terms and associating each combination of matched term weight to a relevance score range [e.g. see col. 3, lines 10-15; the steps 500-580, Fig. 7]; the ranking logic grouping the candidate objects based on the matched term weight where an object that matches a total term weight of M (or total them strength) is associated to a more relevant score range than an object that matches a total term weight less than M; [e.g., see col. 15, lines 58-61; col. 16, lines 39-58; col 17, lines 19-26; col. 23, lines 26-54; Fig. 11A-1 to Fig. 11A-2];



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\* retrieval logic for retrieving a set of most relevant objects associated to the relevance score ranges having a greatest matched term weight [e.g. see step 410-440, Fig. 5; Fig(s). 11-12; col. 25, lines 34-55]; and

\* display the most relevant documents to a user [e.g., see Fig(s). 11A-1; 12].

14. Wical did not expressively disclose his system allows a user to click only those in the highest ranked set document. However, for example, look at Fig. 11A-1, it clearly isolates the first 42 items in the top three-star rank. Thus, it would be obvious to an ordinary skill person in the art, at the time the invention is made, to retrieve only those items, because they are the one's most interested and it would be inefficient to retrieve those of lower interest.

15. As to claim 9, except the features discussed above, Wical further discloses that the search query processing logic including a parser that parses the search query to identify the terms [ e.g., see the theme parser, col. 27, lines 24-39].

16. As to claims 4 and 17, except the features discussed above, Wical further discloses that the system using an inverse frequency scoring to assign the term weight [e.g., the query term weight strength is decreased based on the distance weight, see col. 14, lines 4-5].

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*Response to Arguments*

17. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen, whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436. The fax phone numbers for this group are: (703) 746-7238 (After Final Communication); (703) 746-7239 (Official Communications); and (703) 746-7240 (For Status Inquiries, Draft Communication).

20. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

Dec 7, 2003



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